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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,253	03/03/2004	Alex James Duke	04-134	3974
20306	7590	06/30/2005	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			GROSSO, HARRY A	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			3727	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,253

Applicant(s)

DUKE ET AL.

Examiner

Harry A. Grosso

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Michie (5,142,102).

3. Michie discloses a protective case with a main body (16, Figure 1), and a protective cage having a circular annulus (20) and three or more spokes (26) attaching the annulus to the main body. The case is made of a thermoplastic material which would by its nature have some resiliency.

4. Claim 5 recites that the annulus and the main body are welded to the spokes. Michie discloses the case (10) is molded as a unit (column 2, lines 55-66). The examiner deems this to be structurally equivalent construction.

5. Claims 1, 2 and 6 rejected under 35 U.S.C. 102(b) as being anticipated by Portwood (5,072,846).

6. Regarding claims 1 and 2, Portwood discloses a protective case with a main body (10, 20, Figures 1 and 3) and a protective cage having two circular annuli (14 and 15) and spokes (16, 17) attaching the annuli to each other and to the main body.

7. Regarding claim 6, Portwood further discloses another protective cage having an annulus (26) and spokes 27 attaching the annulus to the main body.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michie.

Claim 4 recites that the annulus has a length parallel to the main body portion equal to about 10% of the length of the main body. Michie discloses the annulus has a length parallel to the main body but does not teach what that length is. However, applicant has not disclosed that having the length of the annulus at 10% of the length of the main body portion solves any stated problem or is for any particular purpose. It appears this is a matter of design choice and the invention would perform equally well with an annulus of greater or lesser length. The case of Michie is inherently capable of being made with the annulus of the desired length and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the annulus of the length deemed desirable.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Portwood.

Portwood discloses the protective case with the protective cages as discussed in paragraphs 6 and 7 above and an annulus (26) has a length parallel to the main body but does not teach what that length is. However, applicant has not disclosed that having the length of the annulus at 10% of the length of the main body portion solves any stated problem or is for any particular purpose. It appears this is a matter of design

choice and the invention would perform equally well with an annulus of greater or lesser length. The case of Portwood is inherently capable of being made with the annulus of the desired length and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the annulus of the length desired.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on 571-272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harry A. Grosso
Examiner
Art Unit 3727

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LEE YOUNG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700